

Opinion of the Court.

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And he cites the following cases as sustaining this view:

Circuit Court of Appeals, First Circuit. *Ball & Socket Fastener Co. v. Ball Glove Fastening Co.*, 58 Fed. 818; *Babcock v. Clarkson*, 63 Fed. 607; *Martin Hill Cash-Carrier Co. v. Martin*, 67 Fed. 786, 787. Since the *Noban Case*, the view thus announced has been approved in the Circuit Court of Appeals of the Second Circuit in *Standard Plunger Elevator Co. v. Stokes*, 212 Fed. 941, 943; of the Third Circuit in *Roessing-Ernst Co. v. Coal & Coke By-Products Co.*, 219 Fed. 898, 899; *Piano Motors Corporation v. Motor Player Corporation*, 282 Fed. 435, 437; of the Fourth Circuit in *Leader Plow Co. v. Bridgewater Plow Co.*, 237 Fed. 376, 377; of the Sixth Circuit in *Smith v. Ridgely*, 103 Fed. 875; *Babcock & Wilcox Co. v. Toledo Boiler Works Co.*, 170 Fed. 81, 85; *United States Frumentum Co. v. Lauhoff*, 216 Fed. 610; *Schiebel Toy & Novelty Co. v. Clark*, 217 Fed. 760, 763; of the Eighth Circuit in *Moon-Hopkins Co. v. Dalton Co.*, 236 Fed. 936, 937; and of the Ninth Circuit in *Leather Grille & Drapery Co. v. Christopherson*, 182 Fed. 817.

We have been speaking of the application of estoppel in the assignment of patents after they have been granted and their specifications and claims have been fixed. The case before us, however, concerns assignment of an invention and an inchoate right to a patent therefor before the granting of it which, after the assignment at the instance of the assignee, ripened into a patent. Section 4805 of the Revised Statutes authorizes the granting of a patent to the assignee of the inventor. The assignment must be first entered of record in the Patent Office, and in all such cases the application must be made and the specification sworn to by the inventor. It is apparent that the scope of the right conveyed in such an assignment is much less certainly defined than that of a granted patent, and the question of the extent of the estoppel

against the assignor of such an inchoate right is more difficult to determine than in the case of a patent assigned after its granting. When the assignment is made before patent, the claims are subject to change by curtailment or enlargement by the Patent Office with the acquiescence or at the instance of the assignee, and the extent of the claims to be allowed may ultimately include more than the assignor intended to claim. This difference might justify the view that the range of relevant and competent evidence in fixing the limits of the subsequent estoppel should be more liberal than in the case of an assignment of a granted patent. How this may be, we do not find it necessary to decide. We can well be clear, however, that if it is proper to limit the estoppel available for an assignee after patent as against his assignor by reference to the state of the art, *a fortiori* is such reference relevant where the estoppel is sought by the assignee before patent. In the light of this conclusion, we must now turn to the facts to which it should be applied.

The art which O'Conor entered was that of a composition of materials for insulating purposes, of leaves of fibrous material like paper superposed one on another and united by an adhesive binder coating the leaves, subjected to heat and pressure and hardened into a compact mass and rendered capable of high resistance to the electric current. In the specification of his patent he disclosed his idea of the defect of the then art, which he proposed to remedy by his process, as follows:

"Heretofore insulation material such as cardboard, composed of layers of paper glued together, has proved more or less unsatisfactory because of various defects, such as absorption of moisture from the atmosphere, inability to resist heat and chemical action, and lack of physical strength. Insulating material . . . must be free from these defects, and, in addition, must possess high dielectric strength."

He proposed to achieve his purpose by use of paper or cardboard, which was old for such purpose, by a binder of bakelite or phenol and formaldehyde, also well known for such use, by hydraulic pressure of 800 lbs. and steam heat, followed by cooling and then by baking in an oven at high heat and low pressure. There was indeed nothing new in O'Conor's invention but the two-step of pressure and heat, cooling and baking. If this two-step process was new, and the estoppel requires us to hold as against O'Conor that it was, his assignee had a right to claim the application of it as new, not only to flat articles of composition but also to non-planiform articles as in the 11th and 12th claims; for though O'Conor had not made such a claim, his original specification foreshadowed it as reasonable. In view of the art, however, it is very clear that the 11th and 12th claims must be read to include as an essential element of the combination therein claimed, the two-step process. Without this, there was nothing new in them in the field to which they applied.

The 11th and 12th claims were made by the company as assignee after O'Conor had left the company's employ and were not allowed until four years after O'Conor had participated in the making of the composition herein complained of, and for three years thereafter the company made no objection to his continuing the manufacture. But it is said, the assignee was entitled on O'Conor's original specifications to base claims which did not contain as an element the two-step process, because the 6th of his original claims was even broader than the 11th and 12th claims as subsequently made and allowed. It was as follows: "The process of manufacturing insulating material which consists in superposing layers of coated paper and applying heat and pressure thereto." This was promptly rejected by the Patent Office as it must have been in the then state of the art. It was so absurdly broad and all-inclusive as almost to

indicate that it was made to be rejected. O'Conor's signature to such a claim under the circumstances of course does not estop him when in fact it was not allowed; and certainly should not be used to bolster up a broad construction of the 11th and 12th claims when, as we have said, the state of the art must limit them.

We are clear then that the estoppel of the 11th and 12th claims against O'Conor does not extend to a single step process such as he has participated in as partner, stockholder or officer; and if it does not affect him, *a fortiori* does it not affect the respondent company.

This result makes it unnecessary for us to consider the objections that the Formica Company is not affected by an estoppel which would operate against O'Conor, or that the alleged nominal character of the consideration moving to O'Conor can not support an estoppel.

*Decree affirmed.*